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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,577	01/16/2001	Fred G. Slavin	P/2167-248	2901

21967 7590 04/20/2006

HUNTON & WILLIAMS LLP  
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EXAMINER

GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/760,577

Applicant(s)

SLAVIN ET AL.

Examiner

Clement B. Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.  
2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-117 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-117 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### **Claim Rejections - 35 USC § 112**

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.  
Claim 25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing
2. to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, Claims 1, 26, 54, and 114, lines 5-6 "said company obligating itself to earn a variable number of consumption points over an agreed to consumption period, it is unclear to whom the said company is obligating its self too in order to earn consumption points"...". For further examination, the examiner interprets the limitation in light of this 112, second rejection.

### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-117, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker U.S. PUB: 2002/0032668, in view of Bachman et al (Hereinafter Bachman U.S. Patent 6,895,386).

As per claims 1-25, Walker discloses a method for permitting a company to sell UPA'S, said method comprising:  
transferring UPA'S (i. e, computers") from said company (i. e, entity") to a second party (i. e, buyer") in return for a cash and or asset payment and wherein said method is implemented on a computerized system (see column 3 paragraph 0048-49 and column 4 paragraph 0063 ).

Walker fails to explicitly teach said company obligating itself to earn a variable number of consumption points over an agreed to consumption period by making future purchases of assets, each purchase having a respective number of consumption points associated therewith.

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However Bachman discloses an embodiment of the present invention allows a customer("i. e, entity") to use a credit card or another financial transaction medium to make purchases of goods and services. The total purchases made over a period are summed and this sum is multiplied by a weighting factor to achieve a weighted sum. Typically the weighting factor is a percentage such that if the customer spends \$100 during a billing cycle, quarter or year, he will receive 1 incentive point if the weighting factor. The weighted sum is added to previously obtained weighted sums to obtain a total weighted sum. A price of an asset is obtained and compared with the total weighted sum. If the weighted sum is at least equal to the price of the asset, a report is sent out requesting an institution to purchase the asset on the customer's behalf and financial Transaction Media (Note abstract and see column 4 lines 35-49).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Walker to include said company obligating itself to earn a variable number of consumption points over an agreed to consumption period by making future purchases of assets, each purchase having a respective number of consumption points associated therewith taught by Bachman in order to increase usage of transaction devices as well as loyalty towards a company by proving incentives to the customers.

As per claims 26-53, Walker discloses a method for permitting a company to sell UPA'S, said method comprising:  
transferring UPA'S (i. e, computers") from said company (i. e, entity") to a second party(i. e, entity") in return for a cash payment from a financial institution wherein said method is implemented on a computerized system (see column 3 paragraph 0048-49 and column 4 paragraph 0063).

Walker fail to explicitly teach said company obligating itself to earn a variable number of consumption points over an agreed to consumption period by making future purchases of assets, each purchase having a number of consumption points associated therewith said financial institution receiving a percentage of each purchase of said assets during said consumption period.

However Bachman discloses an embodiment of the present invention allows a customer("i. e, entity") to use a credit card or another financial transaction medium to make purchases of goods and services. The total purchases made over a period are summed and this sum is multiplied by a weighting factor to achieve a weighted sum. Typically the weighting factor is a percentage such that if the customer spends \$100 during a billing cycle, quarter or year, he will receive 1 incentive point if the weighting factor. The weighted sum is added to previously obtained weighted sums to obtain a total weighted sum. A price of an asset is obtained and compared with the total weighted sum. If the weighted sum is at least equal to the price of the asset, a report is sent out requesting an institution to purchase the asset on the customer's behalf and financial Transaction Media (Note abstract and see column 4 lines 35-49).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Walker to include said company obligating itself to earn a variable number of consumption points over an agreed to consumption period by making future purchases of assets, each purchase having a number of consumption points associated therewith said financial institution receiving a percentage of each purchase of said assets during said consumption period taught by Bachman in order to increase usage of transaction devices as well as loyalty towards a company by proving incentives to the customers.

As per claims 54-84, Walker discloses an electronic marketplace enabling companies to enter into deals for the sale of their UPA's, (i. e, computers") each deal involving at least a company ("i. e, entity") and a UPA buyer and including the sale of UPA'S by said company to said UPA buyer, a cash and/or asset payment to said company(see column 3 paragraph 0048-49 and column 4 paragraph 0063)

and, said system comprising: a marketplace administration system connected to a communication network;

a plurality of user terminals connected to said communication network whereby a plurality of companies and one or more UPA buyers can communicate with said marketplace administration system over said communication network. (see column 4 paragraph 0063 and column 5 paragraph 0072-0073) said marketplace administration

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system presenting a plurality of trading sites to at least some users of said user terminals, said user sites including. (see column 4 paragraph 0063 and column 5 paragraph 0072-0073) one or more UPA trading sites at which said companies can offer to sell their UPA'S to one or more of said UPA buyers, whereby deals can be entered into between said companies and said UPA buyers and relevant parameters of said deals can be entered into said market administration system (see column 4 paragraph 0063 and column 5 paragraph 0072-0073) and one or more sales sites at which said companies can purchase said assets, said sales sites providing (see column 4 paragraph 0063 and column 5 paragraph 0072-0073).

Walker fail to explicitly teach an "indication of both the price of each said asset" and an obligation on the part of said company to purchase future assets to fulfill an agreed to consumption point obligation and the number of consumption points to be awarded upon the purchase of each said asset said marketplace administration system keeping track of said deals and said outstanding balance of consumption points for each said deal.

However Bachman discloses an embodiment of the present invention allows a customer to use a credit card or another financial transaction medium to make purchases of goods and services. The total purchases made over a period are summed and this sum is multiplied by a weighting factor to achieve a weighted sum. Typically the weighting factor is a percentage such that if the customer spends \$100 during a billing cycle, quarter or year, he will receive 1 incentive point if the weighting factor. The weighted sum is added to previously obtained weighted sums to obtain a total weighted sum. A price of an asset is obtained and compared with the total weighted sum. If the weighted sum is at least equal to the price of the asset, a report is sent out requesting an institution to purchase the asset on the customer's behalf and financial Transaction Media (Note abstract and see column 4 lines 35-49).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Walker to include an indication of both the price of each said asset and the number of consumption points to be awarded upon the purchase of each said asset said marketplace administration system keeping track

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of said deals and said outstanding balance of consumption points for each said deal taught by Bachman in order to increase usage of transaction devices as well as loyalty towards a company by proving incentives to the customers.

As per claims 85-113, Walker discloses an electronic marketplace enabling companies to enter into deals for the sale of their UPA's, each deal involving at least a company ("i. e, entity") and a UPA buyer and including the sale of UPA'S by said company to said UPA buyer, a cash and/or asset payment to said company and an obligation on the part of said company to purchase future assets to fulfill an agreed to consumption point obligation, said system comprising:

a marketplace administration system connected to a communication network;  
a plurality of user terminals connected to said communication network whereby a plurality of companies and one or more UPA buyers can communicate with said marketplace administration system over said communication network (see column 3 paragraph 0048-49 and column and column 4 paragraph 0063 and column 5 paragraph 0072-0073) said marketplace administration system presenting a plurality of trading sites to at least some users of said user terminals, said user sites including. (see column 3 paragraph 0048-49 and column and column 4 paragraph 0063 and column 5 paragraph 0072-0073) one or more UPA trading sites at which said companies can offer to sell their UPA'S to one or more of said UPA buyers, whereby deals can be entered into between said companies and said UPA buyers and relevant parameters of said deals can be entered into said market administration system (see column 3 paragraph 0048-49 and column and column 4 paragraph 0063 and column 5 paragraph 0072-0073) and one or more sales sites at which said companies can purchase said assets, said sales sites. (see column 3 paragraph 0048-49 and column and column 4 paragraph 0063 and column 5 paragraph 0072-0073)

Walker fail to explicitly teach an indication of both the price of each said asset and the number of consumption points to be awarded upon the purchase of each said asset said marketplace administration system keeping track of said deals and said outstanding balance of consumption points for each said deal.

However Bachman discloses an embodiment of the present invention allows a customer to use a credit card or another financial transaction medium to make purchases of goods and services. The total purchases made over a period are summed and this sum is multiplied by a weighting factor to achieve a weighted sum. Typically the weighting factor is a percentage such that if the customer spends \$100 during a billing cycle, quarter or year, he will receive 1 incentive point if the weighting factor. The weighted sum is added to previously obtained weighted sums to obtain a total weighted sum. A price of an asset is obtained and compared with the total weighted sum. If the weighted sum is at least equal to the price of the asset, a report is sent out requesting an institution to purchase the asset on the customer's behalf and financial Transaction Media (Note abstract and see column 4 lines 35-49).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Walker to include an indication of both the price of each said asset and the number of consumption points to be awarded upon the purchase of each said asset said marketplace administration system keeping track of said deals and said outstanding balance of consumption points for each said deal taught by Bachman in order to increase usage of transaction devices as well as loyalty towards a company by proving incentives to the customers.

As per claims 114-117, Walker discloses a method for permitting a company to sell UPA'S, said method comprising:  
transferring UPA'S from said company to a second party in return for a cash and/or asset payment and wherein the method is implemented on a computer system (see column 3 paragraph 0048-49 and column and column 4 paragraph 0063 and column 5 paragraph 0072-0073).

Walker fail to explicitly teach said company obligating itself to make future purchases of assets, wherein the amount of future purchases is variable.

However Bachman discloses an embodiment of the present invention allows a customer to use a credit card or another financial transaction medium to make purchases of goods and services. The total purchases made over a period are summed and this sum is multiplied by a weighting factor to achieve a weighted sum. Typically the



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weighting factor is a percentage such that if the customer spends \$100 during a billing cycle, quarter or year, he will receive 1 incentive point if the weighting factor. The weighted sum is added to previously obtained weighted sums to obtain a total weighted sum. a price of an asset is obtained and compared with the total weighted sum. If the weighted sum is at least equal to the price of the asset, a report is sent out requesting an institution to purchase the asset on the customer's behalf and financial Transaction Media (Note abstract and see column 4 lines 35-49).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Walker to include said company obligating itself to make future purchases of assets, wherein the amount of future purchases is variable taught by Bachman in order to increase usage of transaction devices as well as loyalty towards a company by proving incentives to the customers.

### **Conclusion**

### **REPONSE TO ARGUMENTS**

5. Response to arguments filed 1/26/06 has been fully considered but they are moot in view of new grounds of rejections.

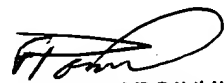
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

March 28, 2006



FRANTZY POINVIL  
PRIMARY EXAMINER  
AU 3628